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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,063	06/24/2004	Kevin Karl Waddell	25791.68.05	5576

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HAYNES AND BOONE, LLP
901 MAIN STREET
SUITE 3100
DALLAS, TX 75202-3789

EXAMINER	
COLLINS, GIOVANNA M	
ART UNIT	**PAPER NUMBER**
3672	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/500,063	WADDELL ET AL.	
	Examiner	Art Unit	
	Giovanna M. Collins	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-9* is/are rejected.

7)☒ Claim(s) *4* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 June 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Gano et al. 6,065,543.

Referring to claim 1, Gano discloses (fig. 1) an apparatus comprising a subterranean formation (66) defining a well, a casing (32) positioned within and coupled to the wellbore; a first tubular liner (28) within the wellbore overlapping with and coupled to the casing, a second tubular (36) overlapping with and coupled to the first tubular by having an end inserted into a machined end (at 60) of the first tubular. The applicant is reminded that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (see MPEP 2113).

Therefore the feature of machining an end of the first tubular liner after the first tubular liner is coupled to the wellbore casing is given no patentable weight.

Referring to claim 5, Gano discloses a system for extracting fluidic materials comprising means (at 32) for coupling an end of a tubular liner to the end of a casing, means (at 34) for machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing; means (at 58) for inserting an end of another tubular liner (36) into the machined end of the tubular liner and means (at 62) for sealing the interface between the other tubular liner and the wellbore casing.

3. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Themig 4,942,925.

Referring to claim 1, Themig discloses (fig.2) an apparatus comprising a subterranean formation (13) defining a well, a casing (16) positioned within and coupled to the wellbore; a first tubular liner (25) within the wellbore overlapping with and coupled to the casing, a second tubular (32) overlapping with and coupled to the first tubular by inserting an end of the second tubular into the machined end of the first tubular. As noted above, the feature of machining an end of the first tubular liner after the first tubular liner is coupled to the wellbore casing is given no patentable weight.

Referring to claim 5, Themig discloses a system for extracting fluidic materials comprising means (at 21) for coupling an end of a tubular liner to the end of a casing, means (at 23) for machining an end of the tubular liner after coupling the tubular liner end to the wellbore casing; means (at 31) for inserting an end of another tubular liner

into the machined end of the tubular liner and means (at 37) for sealing the interface between the other tubular liner and the wellbore casing.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gano "543 in view of Maguire '539.

Referring to claims 2 and 6, Gano disclose a first liner is coupled to the casing but does not disclose the liner is radially expanded to the casing. Maguire teaches a means (see fig. 1, 123) for radially expanding a tubular and that radially expanding the tubular is a method of attaching the tubular to a casing (col. 1, lines 53-60) and eliminates the need for extra slip tools (col. 2, lines 24-27) when attaching tubulars to casings. As it would be advantageous to eliminate the amount of tools need to set a tubular liner, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method and system disclosed by Gano to radially expanding the tubular in order to attach the tubular to a casing and have a means for radially expanding the tubular in view of the teachings of Maguire. The applicant is reminded that even though product-by-process claims are limited by and defined by the process,

determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (see MPEP 2113). Therefore the feature expanding the first tubular liner into engagement before machining the first tubular liner end is not given any patentable weight.

6. Claims 3 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Themig '925 in view of Ledyashov et al. 4809779.

Referring to claim 3, Themig discloses a method from extracting fluidic material comprising coupling an end of a tubular liner (18, 25) to and end of a wellbore casing (16); inserting an end of another tubular liner (32) into a machined end of the tubular liner and sealing the interface between the other tubular liner (at 34) and the casing. Themig does not disclose machining an end of the tubular liner after coupling the tubular liner to the wellbore casing end. Themig discloses that the first tubular liner (18,25) is installed and cemented in place (col. 4, lines 20-25) and then a second tubular (32) is attached to the first tubular. Ledyashov teaches that liners can be machined to clean off material such as cement (see col. 1, lines 28-31) that has built up on the walls of the liner (col. 8, lines 9-14). As it would be advantageous to clean out any cement plugs that may have accumulated in the in the polished bore receptacle to ensure the second liners install will have a good seal in the area, it would be obvious to

one of ordinary skill in the art at the time of the invention to modify the method disclosed by Themig to machine the first tubular after coupling to the well bore casing in view of the teachings of Ledyashov.

Referring to claim 7, Themig discloses a method of conveying fluid material to and from a tubular liner comprising; inserting and supporting an end of another tubular (32) in the machined end of the tubular liner and conveying fluidic material to an from the tubular liner using the other tubular liner (through the inside bore of the liners). Themig does not disclose machining the end of the tubular liner while coupled to the casing end within the wellbore. Themig discloses that the first tubular liner (18,25) is installed and cemented in place (col. 4, lines 20-25) and then a second tubular (32) is attached to the first tubular. Ledyashov teaches that liners can be machined to clean off material such as cement (see col. 1, lines 28-31) that has built up on the walls of the liner (col. 8, lines 9-14). As it would be advantageous to clean out any cement plugs that may have accumulated in the in the polished bore receptacle to ensure the second liners install will have a good seal in the area, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the method disclosed by Themig to machine the first tubular whiled coupled to the well bore casing in view of the teachings of Ledyashov.

Referring to claim 8, Themig discloses the other end (at 33) of the tubular liner (32) extends through the wellbore casing.

Referring to claim 9, as best understood by the examiner, Themig discloses fluidicly sealing the interface between the other end of the tubular liner and the casing (at 37).

Allowable Subject Matter

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 10/17/06 have been fully considered but they are not persuasive. Referring to claims 1 and 5, the applicant argues the Gano and Themig reference do not discloses machining an end of the first tubular liner after the first tubular liner is coupled to the well bore casing. As noted above, that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (see MPEP 2113). Therefore the feature of machining an end of the first tubular liner after the first tubular liner is coupled to the wellbore casing is given no patentable weight.

Referring to claims 2 and 6, these claims are also product by process claims, and therefore the feature of expanding the first tubular liner into engagement before machining the first tubular liner end is not given any patentable weight.

Applicant's arguments with respect to claims 3 and 7-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

gmc

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